

Remarks

Claims 94-128 are pending in this application. Claims 94-128 have been rejected and claim 15 is objected to. Claims 94, 106, 108-110, 113, 117, 120, 121, 123-125, 127 and 128 have been amended. Support for the claim amendments can be found throughout the application, including the claims as originally filed. Importantly, no new matter has been added to the claims. Further, the amendments to the claims should not be construed to be an acquiescence to any of the rejections. The amendments to the claims are being made solely to expedite the prosecution of the above-identified application. Applicant expressly reserves the option to prosecute further the same or similar claims in the instant application or subsequent patent applications entitled to the priority date of the instant application. 35 USC § 120.

Response to Rejections under 35 U.S.C. 112

Claims 106, 108-110, 121, 123-125, 127 and 128 are rejected as being indefinite for failing to find antecedent basis in claims 94 and 113 on which they depend. To address this fact, claims 106, 108-110, 121, 123-125, 127 and 128 have been amended to replace “substrate” or “cyclic substrate” with “chiral cyclic substrate” as is found in independent claims 94 and 113.

Claim 117 has been rejected as being indefinite for failing to find antecedent basis in claim 113 on which it depends. To address this fact, claim 117 has been amended to replace “metal” with “metal atom” as is found in independent claim 113.

Claim 120 has been rejected as being indefinite for failing to find antecedent basis in claim 113 on which it depends. To address this fact, claim 120 has been amended to replace “catalyst” with “non-racemic chiral catalyst” as is found in independent claim 113.

Claims 94 and 113 have also been amended to maintain antecedent basis within the claims themselves. Specifically, “cyclic substrate” has been amended to read “chiral cyclic substrate” and “chiral catalyst” has been amended to read “non-racemic chiral catalyst.” Importantly, no new matter has been added to these claims.

Accordingly, withdrawal of the rejections under 35 U.S.C. 112 is respectfully requested.

Response to Rejections Based on the Judicially-Created Doctrine of Obviousness-Type Double Patenting

Claims 94-128 stand rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-81 of U.S. Patent No. 5,665,890, claims 1-

24 of U.S. Patent No. 5,929,232, and claims 1-29 of U.S. Patent No. 6,262,278. Therefore, to expedite prosecution to allowance of the pending claims, the Applicants submit herewith Terminal Disclaimers, corresponding to the patents cited by the Examiner, that comply with the requirements of 37 CFR 1.321(c). The Disclaimers are accompanied by the required fees. 37 CFR 1.321(c).

Accordingly, withdrawal of the rejections under the judicially-created doctrine of obviousness-type double patenting is respectfully requested.

Fees

The Applicants believe they have provided for the required fee in connection with the filing of this paper. Nevertheless, the Director is hereby authorized to charge any additional required fee to our Deposit Account, 06-1448.

Conclusion

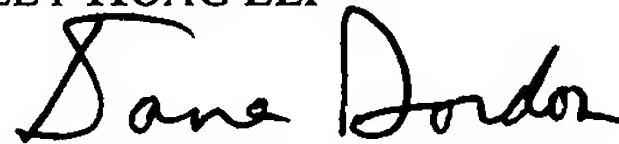
In view of the above amendments and remarks, it is believed that the pending claims are in condition for allowance. If a telephone conversation with Applicants' Attorney would expedite prosecution of the above-identified application, the Examiner is urged to contact the undersigned at (617) 832-1000.

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Respectfully submitted,
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